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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,267	08/31/2000	Meir Eini	00/20309	4053

7590 06/11/2003

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BOSTON, MA 02109

EXAMINER

HAGHIGHATIAN, MINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/11/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,267

Applicant(s)

EINI ET AL.

Examiner

Mina Haghighatian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,4,5,7-12,26,29,30,32-37,40,41 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 4, 5, 7-12, 26, 29-30, 32-37, 40-41 and 43-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

AMENMENT

The amendment filed 04/17/03 was entered. No claims have been cancelled. No new claims have been added. Claims 1, 4, 5, 7-12, 26, 29-30, 32-37, 40-41 and 43-51 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, 5, 7-12, 26, 29-30, 32-37, 40-41 and 43-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added term "solid-free" is not described in the specification and is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 4, 5, 7-12, 26, 29-30, 32-37, 40-41 and 43-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 5, 7-12, 26, 29-30, 32-37, 40-41 and 43-51 are vague and indefinite because they cite "A solid-free",.....carrier....the carrier is semi-solid...". It is not clear how a solid-free carrier can at the same time be semi-solid. It appears that the claims are contradicting themselves.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1, 4, 5, 7-12, 26, 29-30, 32-37, 40-41 and 43-50 under 35 U.S.C. 103(a) as being unpatentable over Vatteret al (6,224,888) is maintained.

The rejection of claim 51 under 35 U.S.C. 103(a) as being unpatentable over Vatteret al (6,224,888) in view of Geria (4,992,478) is maintained.

Response to Arguments

Applicant's arguments filed 04/17/03 have been fully considered but they are not persuasive. It is stated that "Applicant maintain their position that the Vatter patent does not suggest the instantly claimed cosmetic or pharmaceutical carrier because the compositions disclosed therein do not exhibit the instantly claimed carrier properties,

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namely that the carrier is semi-solid at rest and liquefies upon application of shear force thereto". This is not persuasive because as stated before, 1) Vatter discloses formulations (forms) that are considered semi-solid in standing which liquefy by applying shear force thereto, such as foams, gels and mousse. 2) the properties of compositions containing the same ingredients are taken to be the same, meaning they are inherent. The compositions of Vatter are shown to include the solidifying agent and the solvent of the instant claims. The concentration ranges of Vatter also meets the concentration ranges of the instant claims. Therefore it is the Office's position that the compositions of Vatter **will** show the same properties as those of the instant claims.

Applicant argues that "the compositions disclosed in Vatter would not liquefy upon application of shear force because of the presence of oil-insoluble powders (solids) in each disclosed composition. Such solids include inorganic salts, e.g. titanium oxide and zirconium aluminum....". Firstly, even if the newly added term "solid-free" is accepted for the claims, it is in the preamble and the body of the claim. Therefore the composition claims using the open-ended language of "comprising" do not exclude other additives. Secondly, the examples in a document, namely patents, do not encompass the entire teaching. Vatter discloses , very clearly, that "**certain embodiments** of the present invention, preferably lipsticks, pr lip paints, contain... color" (the color or pigments are the solids listed by applicant). Vatter is clearly teaching other cosmetic and pharmaceutical preparations which do not contain "color" such as moisturizers and skin care formulations, including lotions, ointments, emulsions, etc. Vatter meets all the limitations of the instant claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

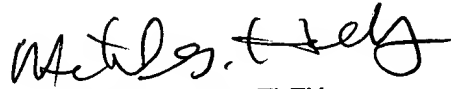
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 703-308-6330. The examiner can normally be reached on core office hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0198.

Mina Haghighatian
June 5, 2003


MICHAEL G. HARTLEY
PRIMARY EXAMINER